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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,380	11/19/2003	David D. Cox	16011/103/106	6709
5909	7590	07/06/2007	EXAMINER	
NAWRICKI, ROONEY & SIVERTSON			GHALI, ISIS A D	
SUITE 401, BROADWAY PLACE EAST			ART UNIT	PAPER NUMBER
3433 BROADWAY STREET NORTHEAST			1615	
MINNEAPOLIS, MN 554133009				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/717,380	COX ET AL.
	Examiner	Art Unit
	Isis A. Ghali	1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 April 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/05/2006</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

The receipt is acknowledged of applicants' IDS filed 12/05/2006, and election filed 04/19/2007.

Claims 1-16 are pending.

### *Response to Election/Restrictions*

1. Applicant's election of Group I, claims 1-14 in the reply filed on 04/19/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
  
2. Claims 15 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups II and III, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 04/19/2007.

Claims 1-14 are included in the prosecution.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: the term "tolylsulfone" is misspelled. Appropriate correction is required.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,839,442. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim 1 and the claims of the issued patent are directed to the same subject matter as follows: adhesive composition comprising acrylic polymer (or mixture of acrylic polymers) and diiodomethyl-p-tolylsulfone. The present claims are

generic regarding the acrylic polymer, and the issued claims are directed to species of the acrylic polymer, therefore, the issued claims anticipate the present claims.

6. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,216,699. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim 1 and the claims of the issued patent are directed to the same subject matter as follows: adhesive composition comprising acrylic polymer (or mixture of acrylic polymers) and diiodomethyl-p-tolylsulfone. The present claims are generic regarding the acrylic polymer, and the issued claims are directed to species of the acrylic polymer, therefore, the issued claims anticipate the present claims.

7. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,503,531. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim 1 and the claims of the issued patent are directed to the same subject matter as follows: adhesive composition comprising acrylic polymer (or mixture of acrylic polymers) and diiodomethyl-p-tolylsulfone. The present claims are generic regarding the acrylic polymer, and the issued claims are directed to species of the acrylic polymer, therefore, the issued claims anticipate the present claims.

8. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,607,746. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim 1 and the claims of the issued patent are directed to the same subject matter as follows: adhesive composition comprising acrylic polymer (or mixture of acrylic polymers) and diiodomethyl-p-tolylsulfone. The present claims are generic regarding the acrylic polymer, and the issued claims are directed to species of the acrylic polymer, therefore, the issued claims anticipate the present claims.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, the expression "majority" does not set forth the metes and bounds of the claim. Recourse to the specification does not define the expression in terms of concentrations or amounts.

Claim 12 recites that the ratio between non-self curing to self curing acrylic resin is between 7 and 10, and this is confusing because between 7 and 10 is not a ratio. If this recitation is considered as ratio 7:10, then the self curing acrylic resin is present in

higher ratio than the non-self curing, contradicting claim 11. Therefore, the ratio recited in claim 12 does not set forth the metes and bounds of the claim. Recourse to the specification does not define the ratio of non-self curing acrylic resin to self curing acrylic resin.

Regarding claims 13 and 14, the expression "solid" does not set forth the metes and bounds of the claim. Recourse to the specification does not define the expression.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of US 4,310,509 ('509) and US 4,602,011 ('011).

US '509 teaches pressure sensitive adhesive has homogenously dispersed therein an antimicrobial agent, and wherein the adhesive is chemically and storage stable and when placed on skin it uniformly and controllably release unaltered antimicrobial agent (abstract). The antimicrobial agent can be iodine containing compounds (col.2, line 45). The adhesive is mixture of Gelva adhesives of 30% solids Gelva 737 (non-self curing acrylic adhesive, and 44% solids Gelva 788 (self-curing acrylic resin (col.5, lines 61-65).

Although US '509 teaches iodine containing compounds as antimicrobial agents, however, the reference does not explicitly teach the diiodomethyl-p-tolylsulfone as the iodine containing antimicrobial agent as claimed by claim 1.

US '011 teaches composition comprising less skin irritating and less toxic antimicrobial agents (col.5, lines 60-63; col.92, lines 58-67). The antimicrobial agents include diiodomethyl-p-tolylsulfone (col.6, line 49).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide pressure sensitive adhesive of mixture of Gelva adhesives has homogenously dispersed therein iodine-containing antimicrobial agent as disclosed by US '509, and replace the iodine-containing antimicrobial agent with diiodomethyl-p-tolylsulfone disclosed by US '011, motivated by the teaching of US '011 that such an antimicrobial agent is less skin irritating and less toxic, with reasonable expectation of having pressure sensitive adhesive of mixture of Gelva adhesives has

homogenously dispersed therein diiodomethyl-p-tolylsulfone, wherein the adhesive composition is stable and less irritating to the skin on use and less toxic.

The combined teachings of US '509 and US '011 does not teach the amount of diiodomethyl-p-tolylsulfone as claimed by claims 3-5, and 8-10. US '509 does not teach the same ratio between the self-curing and non-self curing acrylic resin as claimed by claims 11 and 12.

The amount of the antimicrobial agent can be determined by one having ordinary skill in the art according to the specific intended use.

The ratio between self-curing and non-self curing acrylic resin can be adjusted by one having ordinary skill in the art according to the desired properties of the adhesive according to the site of application and intended use.

14. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of US 4,310,509 ('509) and JP 07101810 ('810).

The teachings of US '509 are discussed above.

Although '509 teaches iodine containing compounds as antimicrobial agents, however, the reference does not explicitly teach the diiodomethyl-p-tolylsulfone as the iodine containing antimicrobial agent as claimed by claim 1.

JP '810 teaches composition comprising diiodomethyl-p-tolylsulfone that is harmless to a human body and has a wide fungicidal spectrum and can prevent the skin from being infected by harmful microorganisms such as yeast and mold, and further treatment of the already infected portion can be expected (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide pressure sensitive adhesive of mixture of Gelva adhesives has homogenously dispersed therein iodine-containing antimicrobial agent as disclosed by US '509, and replace the iodine-containing antimicrobial agent with diiodomethyl-p-tolylsulfone disclosed by JP '810, motivated by the teaching of JP '810 that diiodomethyl-p-tolylsulfone is harmless to a human body and has a wide fungicidal spectrum and can prevent and treat skin infected by harmful microorganisms, with reasonable expectation of having pressure sensitive adhesive of mixture of Gelva adhesives has homogenously dispersed therein diiodomethyl-p-tolylsulfone, wherein the adhesive composition is harmless to the skin and capable of successfully treating skin infected with harmful microorganisms.

The combined teachings of US '509 and JP '810 does not teach the amount of diiodomethyl-p-tolylsulfone as claimed by claims 3-5, and 8-10. US '509 does not teach the same ratio between the self-curing and non-self curing acrylic resin as claimed by claims 11 and 12.

The amount of the antimicrobial agent can be determined by one having ordinary skill in the art according to the specific intended use.

The ratio between self curing and non-self curing acrylic resin can be adjusted by one having ordinary skill in the art according to the desired properties of the adhesive according to the site of application and intended use.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isis A Ghali  
Primary Examiner  
Art Unit 1615

IG

*Isis Ghali*

ISIS GHALI  
PRIMARY EXAMINER